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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/755,029

01/09/2004

Matthew Hall

2857-001

7876

22208

7590

05/03/2006

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EXAMINER

ALI, SHUMAYA B

ART UNIT

PAPER NUMBER

3743

DATE MAILED: 05/03/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/755,029	HALL, MATTHEW	
	Examiner	Art Unit	
	Shumaya B. Ali	3743	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 09 January 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 8/12/04 and 1/9/04 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input checked="" type="checkbox"/> Other: <u>detailed action</u> . |

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claims 1-16 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Further, invention is considered enabling because applicant has not incorporated any reference number in the specification corresponding to the reference number labeled in figures 1-5.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 1-3,7,8,11,13-16 rejected under 35 U.S.C. 102(b) as being anticipated by

Kopacko et al US Patent No. 6,467,483 B1

As to claim 1, Kopacko et al. in figures 1a-9b disclose a flexible Continuous Positive Air Pressure (CPAP) full-face mask (10) for conforming to a wide range of user faces (col.4 lines 65-67), comprising: a full-face mask shell (fig.9, 16), said shell being sized to cover a user's nose and mouth (see fig.9), formed of a flexible, latex-free material (see abstract), and including a peripheral portion; and a seal (38) attached to the peripheral portion of said shell. **as to claim 2**, a positionable guide wire (37) adjacent said peripheral portion of said frame to allow said frame and seal to be positioned to generally conform to the contours of a user's face; **as to claim 3**, positionable guide wire being selected from the group consisting of an embedded metal wire, an embedded metal strip, a surface-mounted metal wire, a surface mounted metal strip, an embedded structure made up of a plurality of positionable metal links, a surface mounted structure made up of a plurality of positionable metal links, an embedded structure made up of a plurality of positionable plastic links, a surface mounted structure made up of a plurality of positionable plastic links, a moldable clay ring, and a moldable plastic ring (fig.1b, 19); **as to claim 7**, an elbow port (fig.1a where 62 is engaged, col.5 line 18) in a lower central portion of said shell; **as to claim 8**, further comprising at least one auxiliary port (74) and port cover (see fig.1a, cover situated above 20), wherein said port cover further includes comers (see fig.1a); **as to claim 11**, further comprising a threaded (see fig.1) elbow assembly attached to said elbow port; **as to claim 13**, further comprising an exhalation vent (74) located on said elbow assembly; **as to claim 14**, further comprising a cover means (situated above 20) for said exhalation vent configured to diffuse or direct exhaled air in a non-objectionable manner.

Apparatus needed to perform the method steps cited in claims 15-16 are disclosed in claims 1-5 above. Whereas the structural limitations are anticipated by Kopacko et al. therefore,

Art Unit: 3743

method steps of claims 15 and 16 can be performed using the apparatus disclosed by Kopacko et al.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. **Claims 4,5,10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kopacko et al US Patent No. 6,467,483 B1 in view of Scarberry US Patent Application Publication No. 2002/0100479**

As to claims 4,5, and 10, Kopacko et al. disclose claimed invention as cited above except for seal is adhesively attached to said shell, however Kopacko is considered to have equivalent means for sealing; **as to claim 5**, Kopacko et al fails to disclose an inner silicone gel cushion and an outer silicone seal that is expandable by positive pressure air of the CPAP full-face mask to seal against a user's face; and **as to claim 10**, Kopacko et al. further fails to disclose wherein said shell is formed of flexible silicone; However, CAPAP mask is known in the art to have silicone gel cushion or inflatable cushion attached to the periphery of the mask for providing tight seal to the wearer with increased comfort. Teachings are found in the reference to Scarberry (see paragraph 6, figure 1, 27,34). Therefore, it would have been obvious to one of

Art Unit: 3743

ordinary skills in the art to include limitations cited for claims 5 and 10 in view of Scarberry to the mask of Kopacko et al. for the purposes of providing tight seal to the wearer with increased comfort.

7. Claims 6 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kopacko et al US Patent No. 6,467,483 B1.

As to claim 6, Kopacko et al. disclose claimed invention as applied for claims 1-5 above except for a five-point attachment. However, in a different embodiment, see figure 9A, Kopacko et al teaches the claimed limitation.

As to claim 14, Kopacko et al. discloses claimed invention as applied above except for wherein said cover means is a clip-on cover configured to direct exhaled air downward. However, Kopacko et al. in figure 1 (see extended cover near reference object 20) teaches an alternative equivalent means, i.e. snap on cover.

Specification

8. The disclosure is objected to because of the following informalities: reference number labeled in the drawings are not found in the detailed description of the embodiment. Appropriate correction is required.

Drawings

9. New corrected drawings in compliance with 37 CFR 1.121(d) are required in this application because applicant has submitted distinct figures with same figure number. Applicant

Art Unit: 3743

is advised to employ the services of a competent patent draftsman outside the Office, as the U.S. Patent and Trademark Office no longer prepares new drawings. The corrected drawings are required in reply to the Office action to avoid abandonment of the application. The requirement for corrected drawings will not be held in abeyance.

Allowable Subject Matter

10. Claim 9 objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

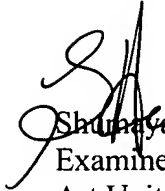
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shumaya B. Ali whose telephone number is 571-272-6088. The examiner can normally be reached on M-F 8:30-4:30.

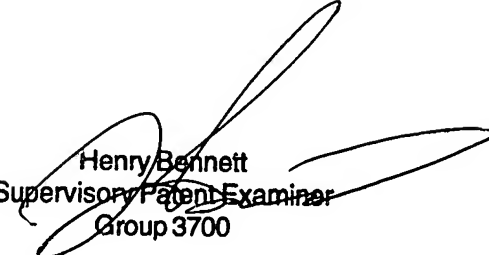
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Henry Bennett can be reached on 571-272-4791. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Application/Control Number: 10/755,029
Art Unit: 3743

Page 7

 5/1/06
Shunpaya B Ali
Examiner
Art Unit 3743


Henry Bennett
Supervisory Patent Examiner
Group 3700